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EXAMINER

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ART UNIT PAPER NUMBER

3629

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--|---|--|
| Office Action Summary | Application No. 09/730,232 | Applicant(s) POLTORAK, ALEXANDER I. | |
| | Examiner Janice A. Mooneyham | Art Unit 3629 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53, 66-72 and 86-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-53, 66-72 and 86-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on February 15, 2005, wherein:

Claims 1-53, 66-72 and 86-88 are currently pending:

Claims 1,21, 39, 52 and 53 have been amended;

Claim 88 has been added.

Response to Amendment

Claim Rejections - 35 USC § 112

2. The applicant has amended the claims and therefore the rejection under 35 USC 112, second paragraph is hereby *withdrawn*.

Claim Rejections - 35 USC § 101

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. In the present case, claims 1-7, 11-16, 19-20 and 39-44 only recite an abstract idea. The recited steps of merely maintaining a user interface, establishing a connection, receiving criteria, searching and presenting results does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to search intellectual property listings. There is not positive recitation of technology in the body of the claims.

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Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

In the present case, the mention of maintaining a user interface site is analogous to non-functional descriptive data. The user interface does not exhibit any functional interrelationship with the way in which the computing processes are performed and thus does not impart functionality to the data or the computer.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 4, 8-10, 20, 39, 45-46 and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by Lundberg (US 2002/0091541) (hereinafter referred to as Lundberg).

Referring to Claims 1, 39, 45 and 48:

Lundberg discloses a method and system for performing the method of searching intellectual property listings, comprising:

- a) maintaining a user-interface site accessible by a plurality of users (Fig. 1);
- b) establishing a connection to a plurality of third-party sources of intellectual property

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listings available for transaction ([0007] *listings available for transacting are records identified according to the criteria and presented to the user for approval to add to the portfolio*)(Fig. 1 (16) *source database of IP asset records*);

c) receiving from at least one of said plurality of users search criteria for searching said plurality of third-party sources of intellectual property listings (Fig. 2 (22) *enter search criteria*);

d) searching said plurality of third-party sources of intellectual property listings according to said search criteria (Fig. 2 (24) *search source database*);

e) presenting a resulting set of intellectual property listings to said at least one of said plurality of users (Fig. 2 (26) *display retrieved hits*); and

f) receiving from said at least one of said plurality of users an identification of those of said resulting set of intellectual property listings that are of interest to said at least one of said plurality of users (Fig. 2, (28-30) *reject unwanted hits; add wanted records to portfolio database*; pages 1-2 [0009]).

Referring to Claim 4:

Lundburg discloses a method further comprising the step of; establishing contact between said at least one of said plurality of users and those of said plurality of third-party sources including those of said resulting set of intellectual property listings which are of interest to said at least one of said plurality of users (Figs. 1-2; *wide access network (16), such as the Internet*).

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Referring to Claim 8:

Lundburg discloses a method wherein the step of searching said plurality of third-party sources includes the steps of:

a) designating a buffer memory for temporary storage of intellectual property listings matching said search criteria (a memory is inherent in the system (Figures 1-2, page 1 [0009] *IP database is searched for records matching the one or more criteria. Client computer displays to the user on the client computer a list of records found in the search (temporary storage of results). User can reject the selected records in the list. Non rejected records are added to user portfolio database (permanent storage);*

b) reformatting said search criteria according to requirements of each of said plurality of third-party sources of intellectual property listings (Figs. 1-2, *records are stored in a database in binary code. To make data readable, it must be reformatted into human readable code);*

c) searching through the intellectual property listings of said each of said plurality of third-party sources for matches with said respective reformatted search criteria (Figs. 1-2 (22) *search source database – the computer is doing the searching. The computer is a machine which only understands machine language, thus the search is performed in a form the machine can read);* and

d) collecting such intellectual property listings that match said reformatted criteria and storing said listings in said buffer memory (Figs. 1-2, *IP database is search and records matching the criteria are displayed to the client as a list in which client can*

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disregard selected records and then store the non-rejected records in the user portfolio database (permanent storage); format is changed to human readable form).

Referring to Claim 9:

Lundburg discloses a method further comprising the step of:
reformatting said intellectual property listings stored in said buffer memory in a predetermined format prior to presentation thereof to said at least one of said plurality of users (Figs. 1-2 *retrieved data is in binary code and must be put into human readable format prior to displaying. Can be via HTML or PDF format*).

Referring to Claim 10:

Lundburg discloses a method further comprising the step of:
reordering (order again) said intellectual property listings stored in said buffer memory according to predefined criteria prior to presentation thereof to said at least one of said plurality of users (Figs. 1-2 [0009] *the client computer displays to the user on the client computer a list or records found in the search; the set can be groomed (by deletion of unwanted records selected in the query) to form a part or all of the desired user portfolio database of IP assets records. Additional records can be added by specifying them one at a time or another group can be selected by executing additional searches using different search criteria [0007]*).

Referring to Claim 20:

Lundburg discloses a method wherein said user-interface site is a website (Figs. 1-2, [0007] *the system including HTML (web contains HTML files) or JAVA based*

browsers interacting through a server computer system through a wide access network such as the Internet).

Referring to Claims 46:

Lundberg discloses a server computer ([0007] (12))

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 21-38 and 49-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tran (US 2002/0095368) (hereinafter referred to as Tran).

Referring to Claims 21 and 49-53:

Tran discloses a method and system for performing the method of searching intellectual property listings online, comprising the steps of:

a) maintaining a user-interface site accessible by a plurality of users ([0007-0008] *a system supports trading of intellectual property (IP) with a user interface; Fig. 1 workstations 104-106*);

b) maintaining access to a predetermined set of third-party sources of intellectual property listings searchable online ([0009] *online trading is done through a network-based community in which buyers and sellers are brought together*; Figure 1; page 1 [0006] thru page 2 [0012]; page 2 [0014] *one or more client workstations 104-*

106 are connected to the network 102. Additionally, an Internet community 110 with one or more service providers, manufacturers, or marketers are connected; see also [0009] the portal provides the user with access to a network of IP lawyers and links the user to IP related business such as those who specialize in trading or mediating IP related issues);

c) eliciting from each user search criteria for searching each of said third-party sources of intellectual property listings (page 1 [0006] thru page 2 [0012], page 3 [0017] a user can simply search for desired assets; [0022] by having access to the member's IP interests, the portal can provide pre-screened, high-quality investment opportunities that match the investor's identified interest [0035] profile is used to create personalized pages for members by dynamically serving-up the content to each user utilizing dynamic HTML, among others [0007] to narrow the list, the inventor can specify one or more parameters or qualifications that the IP affiliates are required to have);

d) designating first and second memory storage areas for storage of intellectual property listings (page 1 [0006] thru page 2 [0012], page 4 [0023] by offloading the storage on the server, the user minimizes the memory required on the client workstation – thus server memory and workstation memory);

Tran does not specifically disclose taking a snapshot.

However, applicant has not defined what applicant means by the term snapshot, thus the Examiner is giving the term the broadest reasonable interpretation which is any retrieved information (list or returned searches) at a point in time. Tran further discloses storing said snapshots as defined by the Examiner in said first memory storage area

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(storing at the server), reformatting each of said snapshots in a predetermined format (storing information at the server and sending it back to client workstation for display requires the information to be reformatted; [0027] the portal incorporates data from multiple sources in multiple formats and organizes (reformats) it into a single, easy-to-use menu); and storing said reformatted snapshots in said second memory storage area (storing information in the client workstation); *searching through the reformatted snapshots in the second memory storage area for matches with the user search criteria (displaying the results from the search and latest updates (see [0023] and [[0025-0026])* .

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take a snapshot of the third party sources, storing the snapshots and reformatting the information so as to be able to incorporate data from multiple sources in multiple formats, provide updates to the information and provide the information in a easy to use format.

Referring to Claim 22:

Tran discloses taking a new (updates) snapshot (see discussion in 21 as to snapshot) (*sends updates to the desktop [[0024], [0026] the assistant checks for the latest updates*), comparing with a new snapshot and updating ([0026] *assistant checks for latest updates and show them [0029] the portal has access to IP search engines that continuously search the web and identify information that is of interest to its users. Search engines use the user profiles to search the web and store the results in user*

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folders) [0035] profile is used to personalize the areas of interest and send updates to the pages that are presented to the user).

Referring to Claim 23:

Tran discloses further comprising the steps of;

p) presenting a resulting set of intellectual property listings to said user (page 1 [0006] thru page 2 [[0012], [0045] *to narrow the list, the inventor can specify one or more parameters or qualifications that the IP affiliates are required to have*); and
q) eliciting from said user an identification of those intellectual property listings which are of interest (page 1 [0006] thru page 2 [0012], [0045] *to narrow the list, the inventor can specify one or more parameters or qualifications that the IP affiliates are required to have*).

Referring to Claim 24:

Tran discloses a method further comprising the step of:

r) securing permission from each of said third-party sources of intellectual property listing allowing search of said third-party sources and presenting listings therefrom to said user (page 3 [0022] *the portal permits sellers to list assets for sale (ie, sellers choose to list assets or grant permission; portal provides access to members,;* page 4 [0024] *agreement*).

Referring to Claim 25:

Tran discloses a method further comprising the step of:

s) securing from each of said third-party sources of intellectual property listings a fee-sharing agreement in respect of any fees paid as a result of transactions arising out of

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contacts initially made through said user-interface site ([0017] *no fees are charged to the buyer for this service; [0020] the system assumes that the seller pays the transfer fee unless otherwise instructed; [0023] transaction usage fee, [0027] pre-determined annual membership fee and transaction fee; [0031] parties can negotiate fees relating to subsequent questions and/or work[0008] specialists can be paid on a commission basis*).

Referring to Claim 26:

Tran discloses a method further comprising the step of:
r) establishing contact between said user and the third party maintaining said intellectual property listings which are of interest (page 1 [0006] thru page 2 [0012] [0011] *portal provides the user with access to a network of IP lawyers for assistance and links the user with IP related businesses*).

Referring to Claim 27:

Tran does not disclose wherein the step of establishing contact includes the step of hyper-linking the user to the third party and transmitting to the third party a unique identifier identifying the user interface site.

However, this would have been obvious to one of ordinary skill in the art at the time of the invention since it is well known in the computer industry to use hyperlinks and unique identifiers so as to provide quick access to resources and to provide some indication of which interface the third party needs to respond to.

Referring to Claim 28:

Tran discloses a method further comprising the step of:

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r) providing said user with a transaction manager ([0025] *Intellectual property assistant (assistant)) to facilitate a contemplated intellectual property transaction (page 1 [0006] thru page 2 [0012]; [0014], [0016], [0025]).*

Referring to Claim 29:

Tran discloses a method further comprising the step of:

s) said transaction manager contacting said third party maintaining the listings of the intellectual property being of interest to said user to facilitate said transaction (page 1 [0006] thru page 2 [0012], [0014], [0016] and [0028] *the search engine will use user profile to search web, store the results and relay information to user. The portal delivers focused IP contents to interested subscribers).*

Referring to Claims 30-32:

Tran does not disclose snapshots.

However, Tran discloses a method further comprising the steps of:

r) designating a memory for temporary storage of intellectual property listings matching said search criteria elicited from said user (page 1 [0006] thru page 2 [0012]) [0023] *a user can rent space on the server to enable him/her to download application software (applets) and /or data anytime and anywhere. By off loading the storage on the server, the user minimizes the memory required on the client workstation - server memory and workstation memory. Applicant has not defined the term snapshot, thus the Examiner is giving the term the broadest reasonable interpretation which is any retrieved information (list or returned searches or updated information) at a point in time; searching through said reformatted snapshots in said*

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second memory storage area for matches with said search criteria (page 1 [0006] thru page 2 [0012]) [see [0017] user can search for desired IP assets [0023] and [0025], and t) collecting such intellectual property listings that match said criteria and storing said listings in said buffer memory (Figs 1, page 1 [0006] thru page 2 [0012] and [0023] server memory enables complex operations to run and yet still ensures that user can access the application and related information anywhere anytime).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take a snapshot of the third party sources, storing the snapshots and reformatting the information so as to be able to incorporate data from multiple sources in multiple formats, provide updates to the information and provide the information in a easy to use format.

Referring to Claims 33-38:

Tran discloses a method further comprising the step of making available to said user analytical tools for valuation and analysis of the intellectual property ([0019] *electronic valuation module to estimate the value of the IP asset*), wherein said analytical tools are not available from the third party maintaining said intellectual property listings which are of interest, further comprising making available to said user escrow services related to a contemplated intellectual property transaction) [0020] *Escrow button allows a buyer and seller to have a neutral third party watch over the title transfer process*), wherein said services are not available from the third party maintaining said listings of said intellectual property which are of interest, comprising the step of making available to said user title insurance covering the intellectual property

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which is the subject of a contemplated intellectual property transaction ([0022] *the portal offers forums providing articles, insights and information about insurance*), wherein said title insurance is not available from the third party maintaining intellectual property listings which are of interest, further comprising the step of making available to said user patent validity insurance covering the intellectual property which is the subject of a contemplated intellectual property transaction, wherein said patent validity insurance is not available from the third party maintaining said intellectual property listings which are of interest ([0022] *insurance*) further comprising the step of making available to said user consulting services related to a contemplated intellectual property transaction, further comprising the step of making available to said user legal services related to a contemplated intellectual property transaction [0030-0031] *the portal allows user to draft applications; a network of independent patent attorneys can perform checks*) (pages 2-3 [0016], [0019], pages 3-4 [0022]).

6. Claims 2-3, 5-7, 11-20, 40-44, 47, 66-72, and 86-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundberg as applied to claims 1 and 39 and further in view of Tran.

Referring to Claim 2:

Lundberg does not disclose securing permissions.

However, Tran discloses a method further comprising the step of:

r) securing permission from each of said third-party sources of intellectual property listing allowing search of said third-party sources and presenting listings

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therefrom to said user (page 3 [0022] *the portal permits sellers to list assets for sale; portal provides access to members; page 4 [0024] agreement*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Tran with the method of Lundberg so as to facilitate the licensing and trading of IP assets between buyers who are looking to buy and sellers who actually want to sell.

Referring to Claim 3:

Tran discloses a method further comprising the step of:

s) securing from each of said third-party sources of intellectual property listings a fee-sharing agreement in respect of any fees paid as a result of transactions arising out of contacts initially made through said user-interface site ([0017] *no fees are charged to the buyer for this service; [0020] the system assumes that the seller pays the transfer fee unless otherwise instructed; [0023] transaction usage fee, [0027] pre-determined annual membership fee and transaction fee; [0031] parties can negotiate fees relating to subsequent questions and/or work; [0008] IP specialists can be paid on a commission basis*).

Referring to Claims 11-16, 40-42, 86-88:

Lundburg discloses the invention as set forth in Claims 1 and 39.

Lundburg does not disclose the goods comprising business available for sale or merger, goods comprising venture capital, a transaction manager to facilitate a contemplated transaction or an Internet auction site.

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However, Tran discloses wherein said goods comprise businesses available for sale, merger or acquisition, wherein said goods comprise venture capital available for investment [0009] and [0022] *portal provides access to non-IP resources including venture capitalists and analyst*), further comprising providing a transaction manager ([0025] *intellectual property assistant*) to facilitate a contemplated transaction between said user and the provider of said goods or services, wherein said third-party listings are comprised by Internet auction sites ([0006] *system supports purchasing or selling with a computerized bid, auction and sale system over a network such as the Internet; page 2 [0016] thru page 4 [0022]*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the trading method of Tran with intellectual property management method of Lundberg so as to enhance the licensing and trading of IP assets and to offer a quick-to-market, flexible business model that can be customized to fit the IP needs of any industry and to target technology without taking a long time to find a buyer for each available technology.

Referring to Claims 5:

Neither Lundberg nor Tran disclose wherein the step of establishing contact includes the step of hyper-linking the user to the third party and transmitting to the third party a unique identifier identifying the user interface site.

However, this would have been obvious to one of ordinary skill in the art at the time of the invention since it is well known in the computer industry to use hyperlinks

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and unique identifiers so as to provide quick access to resources and to provide some indication of which interface the third party needs to respond to.

Regarding Claim 6 and 7:

See the discussion as to claims 26-27, and 28-29:

Referring to Claim 17:

Tran discloses taking a new (updates) snapshot (see discussion in 21 as to snapshot) (*sends updates to the desktop* *[[0024], [0026] the assistant checks for the latest updates), comparing with a new snapshot and updating ([0026] assistant checks for latest updates and show them [0029] the portal has access to IP search engines that continuously search the web and identify information that is of interest to its users. Search engines use the user profiles to search the web and store the results in user folders) [0035] profile is used to personalize the areas of interest and send updates to the pages that are presented to the user).*

Referring to Claim 18:

See the discussion as to claim 8.

Referring to Claims 19 and 43:

Tran discloses the third party sources as Internet auction sites (*[[0006] auction and sale system over a network such as the Internet).*

Referring to Claims 20, 44 and 47:

Tran discloses wherein the user interface is a website (*[0016] user interface is a web-based user interface) and third party user interface sites comprise Internet auction sites {0006] auction and sale system over the Internet)*

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Referring to Claims 66-72:

Tran discloses method and system for searching intellectual property listings online, comprising:

a) making available to a user a software application for installment on said user's computing device, said application comprising instructions to (page 4 [0023]):

i. execute a query as specified by said user (page 4 [0023] and [0029] *search engines use the user profiles to search the web; profile information including company affiliations, occupations, etc [0010]);*

ii. search predetermined Internet sites and exchanges (page 4[0023] and [0045] *the process can select an IP affiliate for marketing the IP asset. In this process, upon registration with the portal, the inventor or IP owner is shown a list or directory of IP affiliates);*

iii. display search results to said user via said terminal, said search results comprising one or more intellectual property listings ([0045] *IP owner is shown a list or directory);* and:

iv. enabling said user to indicate a listing of interest (page1 [0006] thru page 2 [0012], *[0010] profile contains areas of interests [0045] to narrow the list the inventor can specify one or more parameters or qualifications that the IP affiliates are required to have);* and

b) assigning a transaction manager (*intellectual property assistant ([0025])*) to contact said user and the source of said listing to facilitate a desired transaction related to said

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listing of interest ([0016] and [0029] portal delivers focused IP contents to interested subscribers).

Response to Arguments

7. Applicant's arguments filed February 15, 2005 have been fully considered but they are not persuasive.

As to the applicant's argument that the Lundberg does not provide the limitation of establishing a connection to sources of intellectual property listings available for transaction, the Examiner disagrees. Available for transacting is a broad concept.

The Microsoft Computer Dictionary defines the term transaction as:

A discrete activity within a computer system such as an entry of a customer order or an update of an inventory item. Transactions are usually associated with database management, order entry, and other online systems.

Lundsberg discloses an Internet based method and system for organizing records into user portfolios by retrieving or selecting a set of IP asset records from a source database of IP records [0007]. This is a discrete activity within a computer system.

As to the applicant's argument that Lundberg does not disclose establishing contact between the plurality of users and a plurality of third party sources including those of said resulting set of IP listings which are interest to said at least one of the plurality of users, the Examiner respectfully disagrees.

The Merriam Webster Online Dictionary defines the term contact as:

Main Entry: **¹con·tact** ⚔

Pronunciation: 'kän-"takt

Function: *noun*

Etymology: French or Latin; French, from Latin

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contactus, from *contingere* to have contact with --
more at CONTINGENT

1 a : union or junction of surfaces **b** : the apparent touching or mutual tangency of the limbs of two celestial bodies or of the disk of one body with the shadow of another during an eclipse, transit, or occultation **c** (1) : the junction of two electrical conductors through which a current passes (2) : a special part made for such a junction

2 a : ASSOCIATION, RELATIONSHIP **b** : CONNECTION, COMMUNICATION **c** : an establishing of communication with someone or an observing or receiving of a significant signal from a person or object <radar *contact* with Mars>

3 : a person serving as a go-between, messenger, connection, or source of special information <business *contacts*>

4 : CONTACT LENS

Lundberg discloses an Internet based method for organizing records into user portfolios. The contact is through this Internet based network, the wide access network (16).

As for the applicant's argument's that Lundberg does not disclose reformatting or reordering the intellectual property listings, the applicant is directed to the discussion in the rejection.

Dictionary.com defines the term reordering as:

re·or·der (rē-ôr'dər)

v. **re·or·dered, re·or·der·ing, re·or·ders**

v. tr.

1. To order (the same goods) again.
2. To straighten out or put in order again.
3. To rearrange.

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v. intr.

To order the same goods again.

n.

A further order of goods from the same supplier.

The applicant argues that Trans does not disclose a step of maintaining access to a predetermined set of third party sources of intellectual property listing searchable online. The Examiner disagrees.

Tran discloses "maintaining access" in Figure 1 which shows an environment for processing intellectual property assets via a server connected to a network such as the Internet with one or more client workstations connected to the network and an Internet community with one or more services providers can communicate with users [0014].

Merriam Webster Online Dictionary defines the term "third party" as:

Main Entry: **third party**

Function: *noun*

1 a : a major political party operating over a limited period of time in addition to two other major parties in a nation or state normally characterized by a two-party system **b** : MINOR PARTY

2 : a person other than the principals <a *third party* to a divorce proceeding>

The Examiner uses definition (2) to define third party. The system in Tran supports purchasing and selling of intellectual property products and services over a

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network such as the Internet. The technique provides the IP owners with access to an open market for trading IP. Thus, Tran discloses third parties.

As for Tran disclosing a snapshot, the applicant is directed to the discussion with the rejection.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is taken from the Tran [0027].

As for the arguments to the Magid reference, the Examiner has deleted this reference, and therefore, the arguments are moot.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

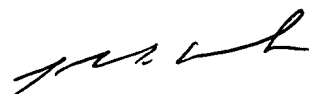
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM



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